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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

YOON, TAE H

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/060-126

Applicant(s)

Reitze et al

Examiner

T. Yoon

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6-14-01, Pre. Amdf
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 and 12-29 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 and 12-29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recited relationship of a carbon atom with H and a carbon atom with OH is not adequately described in the specification. Polyols on page 8 of the specification would have adjacent carbon atoms with H and carbon atoms with OH (such as H-C-OH).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 17-21 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Improper Markush language is recited, and an insertion of "the group consisting of" after "selected from" is needed.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-10 and 12-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Adelman et al (US 4,131,575).

Adelman et al teach a polycarbonate (homopolymer of bisphenol A) composition containing a mold release agent, pentaerythritol tristearate or esters from one mol of pentaerythritol (4 OH groups) and 2.4 moles of stearic acid (2.4 COOH groups) and 0.3 moles of dodecane diacid (0.6 COOH groups), in examples 11, 12, 14 and 14. Various additives and molded articles are taught at col. 5, lines 15-33. The use of less than 0.1 wt% of a mold release agent at col. 2, lines 25-28.

Thus, the instant invention lacks novelty.

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Claims 1-10 and 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575).

The instant invention further recites the equal number of ester and hydroxyl groups.

However, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to make and use a pentaerythritol distearate, for example, Adelman et al since Adelman et al teach partial esters absent showing otherwise.

Claims 1-10 and 12-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adelman et al (US 4,131,575) in view of Dunay et al (US RE 37,200) or EP 0 511 640.

The instant invention further recites a polycarbonate having trimethylcyclohexyl bisphenol component and compact discs and DVDs over Adelman et al.

However, Adelman et al teach various structures for polycarbonates at cols. 3 and 4 which encompass trimethylcyclohexyl bisphenol of Dunay et al (col. 3, lines 59-60). The use of polycarbonates as optical information disks is routine in the art as taught by EP (page 2, lines 1-15).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize trimethylcyclohexyl bisphenol of Dunay et al in Adelman et al in order to make copolycarbonates since Adelman et al teach various substituted bisphenols, or to make compact discs and DVDs in Adelman et al by teaching of EP since the use of polycarbonates as optical information disks is routine in the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/August 1, 2002



TAE H. YOON
PRIMARY EXAMINER